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MESSAGE:

In re Application No.: 10/735,369, Filed: December 12, 2003
First Named Inventor: Ackerman, et al.
Docket No.: 21635-0117

Please deliver to Examiner BAREFORD, Art Unit 1762

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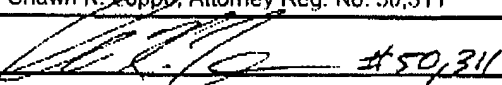
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	Filing Date	December 12, 2003	
	First Named Inventor	ACKERMAN, et al.	
	Art Unit	1762	
	Examiner Name	BAREFORD	
Total Number of Pages in This Submission	21	Attorney Docket Number	130014/11922 (21635-0117)

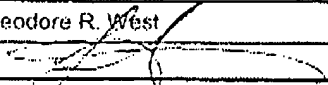
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Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Ackerman et al.)
Application No.: 10/735,369) Group Art Unit: 1762
Filed: December 12, 2003) Examiner: Katherine A. BAREFORD

For: ARTICLE PROTECTED BY A THERMAL BARRIER COATING HAVING A GROUP
2 OR 3/GROUP 5 STABILIZATION-COMPOSITION-ENRICHED SURFACE

Mailstop APPEAL BRIEF - PATENTS
Commissioner for Patents
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APPLICANT'S REPLY UNDER 37 C.F.R. §41.41

Sir:

Applicant files this Reply Brief under 37 C.F.R. §41.41 in response to the Examiner's Answer mailed January 9, 2006.

Applicant replies to those points requiring a reply under Section 10 - Response to Argument in the Examiner's Answer. Applicant organizes its Reply in the same manner as in the Appeal Brief and Examiner's Answer.

Applicant requests that the Board use Applicant's arguments as presented in the Appeal Brief and in this Reply, not the characterization of Applicant's arguments in the Examiner's Answer.

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-2-

Overview

The unifying theme of the Examiner's Answer appears to be a proposal for a new legal standard by stating an obviousness rejection (either obviousness-type double patenting or obviousness under 35 USC 103) in terms of a "can be" standard. The "can be" obviousness rejections improperly combine the law of obviousness (35 USC 103) and the law of anticipation (35 USC 102) and exhibit impermissible hindsight.

The applied "can be" standard is contrary to the actual legal standard of the MPEP, which is that the prior art "teaches" a relation between a prior art reference and the claims at issue. An example of this theme of the rejections is concisely presented at pages 4-5 and 26-28 of the Examiner's Answer, in the sections dealing with the rejection of claims under Ground 2, a 35 USC 103 rejection over Ackerman U.S. 2003/0059633," but its approach is used in relation to all four of the obviousness rejections.

At page 5, lines 5-8, the explanation of the rejection asserts that "According to Ackerman, the first element can be a material...The second element can be selected...[emphasis added]" There is a vast difference between the examiner's "can be" legal standard and the MPEP's "teaches" legal standard. Under the examiner's erroneously applied "can be" legal standard, there is no check on hindsight reconstruction of the claim limitations, which is reflected by the rejections.

The examiner's argument fails to show that the prior art reference teaches the claim limitation, as is required by MPEP 2143.03, which provides "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art". [emphasis added]. As to one of the important limitations found in every claim, the examiner readily admits that Ackerman does not teach the limitation and that "Ackerman, of course, provides for other combinations that are outside of the scope of appellant's claims." (See Examiner's Answer, page 27, lines 10-11). With such an admission, the rejection cannot overcome the hurdle that the art permits some combinations that are outside the scope of the claim language and permits some combinations that are within the scope of the claim language, with absolutely no guidance on what to select absent impermissible hindsight. Selecting only the helpful disclosure, and ignoring the unhelpful disclosure, is a per se hindsight reconstruction.

In an ineffective attempt to avoid the problem of hindsight recreation, the rejection adopts a combination of sec. 102 legal analysis and sec. 103 legal analysis. At page 27, lines 14-15, the premise of the next section shifts to an analysis based on sec 102, relying

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-3-

on MPEP 2131.02. This MPEP section deals with species/genus rejections under sec. 102, but has nothing to do with the teachings necessary under sec. 103, see MPEP 2143.03. The sec. 102 argument continues from page 27, line 14 to page 28, line 5. Then, the argument shifts back to a sec. 103 obviousness argument for some other claim limitations.

Introducing the law dealing with sec. 102 into a sec. 103 rejection circumvents the mandate of MPEP 2142, 2143, and 2143.01, as well as the case authority that forbids hindsight reconstruction of limitations of the pending claims. In each case of the rejections of Grounds 1-4, the rejection is based upon obviousness (either obviousness-type double patenting or 35 USC 103) because the reference clearly does not disclose all of the claim limitations as required by 35 USC 102.

In order to make the obviousness type rejection "work" under the "can be" standard, it is necessary to do a straightforward hindsight reconstruction. In each case, the examiner admits that the prior art teaches some features within the scope of the invention and some features that are not within the scope of the invention, without any teaching as to why one would select only those that are within the scope of the invention. Selection of only those within the scope of the invention is clearly forbidden by the MPEP and the principles of hindsight reconstruction.

Ground 1. Claims 1, 2, 5-12, and 15-20 are rejected under the doctrine of obviousness-type double patenting over claims 14-18 of U.S. Patent 6,887,588.

Claims 1, 6, and 7

The examiner appears to controvert the examiner's own prior statements and admission concerning the scope of the teachings of '588. The explanation of the rejection admits "... '588 teaches all the features of these claims except that (1) of the listed inhibitor material, one of group 2 or 3 of the periodic table and one of group 5 of the periodic table are selected...(3) the ratios of the inhibitor elements." This admission is factually correct.

The Examiner's Answer does not renounce or even explain this admission. Particularly in the circumstances of an obvious-type double patenting rejection, if a key teaching is absent from the prior patent, no rejection ought even to be set forth in the first instance. Yet, in this case, a rejection continues to be improperly asserted and maintained.

The apparent thrust of the examiner's position is to argue that even though '588 admittedly does not teach the presently recited limitations, it somehow makes these limitations "obvious."

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-4-

As to the claim limitation "the stabilization composition comprises a first element selected from Group 2 or Group 3 of the periodic table, and a second element selected from Group 5 of the periodic table," the examiner's argument is a mixture of inapplicable arguments about sec. 102 rejections and arguments that the claims of the '588 parent are not inconsistent with the presently recited limitations. At page 12, line 16-18, an argument is presented regarding the rejection of Markush claims over prior art. There is no issue here related to rejection of Markush claims. The issue here is whether the above-quoted limitation is obvious in view of claims 14-18 of the '588 patent. Nothing in claims 14-18 suggests selecting a first element from Group 2 or Group 3, and a second element from Group 5.

A large number of groupings of elements can be developed from the teachings of claim 16 of '588, beyond those of the present claims. For example, the first element "can be" a lanthanide rare earth, and the second element "can be" a Group 2 or Group 5 element. Or the first element "can be" a lanthanide rare earth or a Group 2 element, and the second element "can be" a Group 5 element. Or the first element "can be" a lanthanide rare earth or a Group 2 or Group 3 element, and the second element "can be" a Group 3 element. Or the first element "can be" a Group 2 or Group 5 element, and the second element "can be" a Group 3 element. Or the first element "can be" barium, and the second element "can be" a Group 3 element. The list goes on to hundreds of potential groupings of elements.

The Examiner's Answer never explains why the examiner focused on the case where first element "can be" a Group 2 or Group 3 element, and the second element "can be" a Group 5 element, rather than one of these other combinations. The only possible answer is impermissible hindsight in light of knowledge gleaned from the present claims.

It is at this point that the arguments of obviousness and anticipation get mixed together. Beginning at page 12, line 10, there is an argument "a reference does not have to specifically describe only the claimed invention of appellant..." The examiner does not reveal at this point the legal authority for this line of argument. However, at page 27, line 16 the Board will find the same argument, word-for-word, preceded by the word "Thus". The "thus" refers back to the asserted legal basis for the argument found in the prior sentence, which is stated to be premised on MPEP 2131.02. MPEP 2131.02 sets forth the law under 35 USC 102 dealing with genus-species situations. The examiner has constructed the "can be" obviousness-type double patenting rejection by relying on the law of obviousness for some of the limitations and the law of anticipation for others thereby avoiding an explanation

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-5-

of the hindsight reconstruction actually needed to select the case where the first element is a Group 2 or Group 3 element, and the second element is a Group 5 element.

As to the claim limitation "the atomic ratio of the amount of the first element to the amount of the second element is at least 1:3," the whole argument is "the amount...would clearly be optimized as a result effective variable...because...one would need to know how much to use..." (sentence bridging pages 12-13 of the Examiner's Answer, emphasis added). The first problem with this argument is that any amount or ratio of elements would be acceptable based on what is taught in claims 14-18 of '588. The second problem with this argument is that, legally, it is those skilled in the art that must first recognize that a parameter is a result-effective variable to quality under the principles of "routine experimentation," without the benefit of the later, claimed invention. In this case, nothing in the art establishes the variable of the ratio of the Group 2/3 to Group 5 elements as having significance; nothing in the art even mentions the ratio of Group 2/3 to Group 5 elements as having significance. Nothing even suggests segregating consideration of elements into Group 2/3 elements and Group 5 elements. That is all hindsight reconstruction by the examiner.

In a final effort to create an argument, it is asserted that "Applicant has made no showing of criticality or unexpected results as to this range." That is not true. Para. [0018] and [0035] of the as-filed Specification explain the selection of this range. No "showing" in an experimental sense is required until a prima facie case of obviousness has been made, and that is not the case here.

Claim 2

As noted in the Appeal Brief, the explanation of the rejection admits, "... '588 teaches all the features of these claims except that...(2)...the substrate nickel-base superalloy" (Final Office Action, page 3, lines 16-19). That is, the examiner admits that the art that is the basis of the rejection does not teach the limitation.

Regarding the issue of "well known", the examiner asserts that a timely traverse was not made. In fact, Applicant traversed the attempted use of "well known" prior art on the first occasion that the rejection which is Ground 1 of the appeal was set forth.

The subject of Ground 1 of the appeal is a non-provisional double patenting rejection.

The Office Action of March 28, 2005, has no non-provisional double patenting rejection. It has a "provisional" double patenting rejection "because the conflicting claims

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-6-

have not in fact been patented." The present rejection that is the subject of Ground 1 is not the "provisional" double patenting rejection set forth in the Office Action of March 28, 2005. The provisional double patenting rejection exists to make the applicant aware of a possible double patenting issue, but is not itself the double patenting rejection. On March 28, 2005, the '588 patent had not yet issued, and therefore no non-provisional rejection could be made. Instead, a hypothetical "provisional" rejection was set forth to make Applicant aware of a potential double patenting issue that might arise in the future. Applicant chooses not to comment in detail on a "provisional" double patenting rejection, because any such comment may constitute prosecution history estoppel that never really had to appear in the prosecution history until there was a non-provisional double patenting rejection, and was gratuitously present in the event that the provisional double patenting rejection was never made non-provisional.

After the Office Action of March 28, 2005, the examiner withdrew the "provisional" double patenting rejection and issued a new non-provisional double patenting rejection that is the subject of Ground 1 of the appeal. The first Office Action to state the non-provisional double patenting rejection that is Ground 1 of the appeal is the Office Action dated June 28, 2005. In the response to the non-provisional double patenting rejection set forth in the Office Action dated June 28, 2005, Applicant timely traversed the "well known" assertion. Applicant made a timely traverse of the attempted "well known" art.

Regarding the suggestion that Ackerman U.S. 2003/0059633 and Subramanian U.S. 6,677,064 were then advanced, if an examiner wishes to rely on prior art to support a rejection, it must be made a part of the statement of the rejection. As stated in Deputy Commissioner Kunin's memorandum of February 21, 2002, entitled "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice," when challenged examiners who seek to rely on such assertions of "common knowledge" must cite and apply an appropriate documentary reference. The CCPA in In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n.3 (CCPA 1970) indicates that where a reference is relied upon to support a rejection, whether or not in a minor capacity, there is no reason for not positively including the reference in the statement of the rejection. This requirement has not been met.

Claim 5

The explanation of the rejection admits, "...588 teaches all the features of these claims except that...(2) the thermal barrier material is a ceramic such as yttria stabilized

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-7-

zirconia..." That is, the examiner admits that the art that is the basis of the rejection does not teach the limitation.

As to the attempt to rewrite the history of the application and Applicant's timely traversal of the "well known" assertion, Applicant incorporates from above the discussion regarding Claim 2.

Claim 8

As the examiner observes, the recited pairs of elements are not taught in the '588 patent.

Claims 9-10

Claims 9-10 recite co-depositing, a subject not mentioned in any way in claims 14-18 of the '588 patent.

The Examiner's Answer argues that it is necessarily true that the two elements will be co-deposited in '588, but that is not the case at all. If multiple inhibitor elements are selected, they may be deposited in multiple solutions, note the open-ended claim language.

Claim 11

Once again, "routine experimentation" is invoked based on a patent examiner's hindsight reconstruction, not upon anything found in the reference. Nothing in the reference suggests any reason to experiment on the ratio of elements. See the above discussion under the heading "Claims 1, 6, and 7", which is incorporated here.

Claims 12 and 15-16

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 17

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-8-

Claim 18

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 19

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 20

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Ground 2. Claims 1-20 are rejected under 35 USC 103 as unpatentable over Ackerman U.S. 2003/0059633.

Claims 1-5

The Examiner's Answer admits that Ackerman does not explicitly teach the claim limitations, such as the limitation of claim 1:

"the stabilization composition comprises a first element selected from Group 2 or Group 3 of the periodic table, and a second element selected from Group 5 of the periodic table"

The examiner continues to adhere to the "can be" standard proposed in the rejections. The essence of this rejection is that if a set of elements "can be" defined with respect to the present invention only with the benefit of possession of an application describing the present invention, the reference contains the "teaching" required by MPEP 2143.03 and the related authority.

This is a per se hindsight reconstruction of the invention. As the examiner admits, the proposed combination of teachings includes combinations within the scope of the claims and combinations outside the scope of the claims, but the examiner chooses to select only

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-9-

those combinations that are within the scope of the claims. In re Fine 5 USPQ2d 1596, 1600 (Fed.Cir. 1988) has made it clear that hindsight reconstruction is not proper:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Further on this point, the Federal Circuit in W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303 (Fed. Cir., 1983) has emphasized that

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." 220 USPQ 303, 312-313

In In re Mercer, 185 USPQ 774, 778 (CCPA 1975), the CCPA stated:

"The Board's approach amounts in substance, to nothing more than a hindsight 'reconstruction' of the claimed invention by relying on isolated teachings of the prior art without considering the over-all context within which those teachings are presented. Without the benefit of appellant's disclosure, a person having ordinary skill in the art would not know what portions of the disclosure of the reference to consider and what portions to disregard as irrelevant, or misleading. See In re Wesslau, 53 CCPA 746, 353 F.2d 238, 147 USPQ 391 (1965)."

The examiner then seeks to rely on the 1971 case In re McLaughlin (Examiner's Answer, page 28, lines 5-13). In re McLaughlin is cited as support for the proposition that hindsight reconstruction is proper. It is not clear why In re McLaughlin is relied upon, as it deals with the basis for combining the teachings of references, not hindsight reconstruction based on the teachings of a single reference.

As stated in In re Fine, 5 USPQ2d 1596, 1599 (Fed.Cir. 1988):

Obviousness is tested by 'what the combined teachings of the references would have suggested to those of ordinary skill in the art.' In re Keller, 208

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-10-

USPQ 871, 881 (CCPA 1981). But it 'cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hosp. Sys. [cite omitted]. And 'teachings of references can be combined only if there is some suggestion or incentive to do so.' Id. Here, the prior art contains none." [emphasis in original]

Thus, hindsight reconstruction is improper, whether used to modify the teachings of a reference or combine the teachings of two or more references. MPEP 2142 recognizes this principle:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. [references omitted, emphasis added].

The thrust of the rejection based upon Ackerman has been to select particular teachings of the reference that are argued to support the rejection, but ignore those which teach away from the invention. The selective use of only the helpful teachings of a reference, and not giving weight to the overall teachings of the reference, in this manner is a per se hindsight reconstruction. This approach is not proper. In In re Mercer, 185 USPQ 774, 778 (CCPA 1975), the CCPA stated:

"The relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention to one having ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention. See In re Lunsford, 53 CCPA 986, 357 F.2d 380, 148 USPQ 716 (1966)."

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-11-

"The Board's approach amounts in substance, to nothing more than a hindsight 'reconstruction' of the claimed invention by relying on isolated teachings of the prior art without considering the over-all context within which those teachings are presented. Without the benefit of appellant's disclosure, a person having ordinary skill in the art would not know what portions of the disclosure of the reference to consider and what portions to disregard as irrelevant, or misleading. See *In re Wesslau*, 53 CCPA 746, 353 F.2d 238, 147 USPQ 391 (1965)."

The second line of argument, discussed in the Overview section above, seeks to mix the legal theories of anticipation under 35 USC 102 and obviousness under 35 USC 103. See, for example, page 27, line 14-page 28, line 13 of the Examiner's Answer. The examiner's argument is built upon MPEP 2131.02, which is an MPEP section dealing with sec. 102 rejections in genus-species situations. If the examiner wished to make a sec. 102 rejection, that should have been done. But it is improper to make a 35 USC 103 obviousness rejection and then try to base the rejection on citations of the law of 35 USC 102.

At page 27, line 14-page 29, line 15, it is argued that the recited limitation:

"the atomic ratio of the amount of the first element to the amount of the second element is at least 1:3"

is obvious in view of Ackerman. This is a particularly difficult argument to make, in view of the admission found in the explanation of the rejection (Examiner's Answer, page 6, lines 8-9):

"Ackerman teaches all the features of these claims except the atomic ratio of the amount of the first element to the second element."

Ackerman does not teach the "first element selected from Group 2 or Group 3 of the periodic table, and a second element selected from Group 5 of the periodic table," and it does not teach any ratio. But, in the argument of the hindsight reconstruction that is not based on anything found in the Ackerman reference, "...the amount...would clearly be recognized as a result-effective variable..." (Examiner's Answer, page 28, lines 18-20, emphasis added).

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-12-

Claim 6

The basis for the argument is to mix legal theories under sec. 102 and the examiner's newly proposed sec. 103 "can be" approach, selecting them as may be convenient to reconstruct the rejection. In this sec. 103 rejection, the main argument is MPEP 2131.02 (Examiner's Answer, page 31, line 2), which is a sec. 102 provision. That is, the examiner implicitly admits that the reference does not teach the limitations of claim 6, and is applying an attempted work-around to avoid the restriction against hindsight reconstruction.

Claim 7

The basis for the argument is to mix legal theories under sec. 102 and the examiner's newly proposed sec. 103 "can be" approach, selecting them as may be convenient to reconstruct the rejection. In this sec. 103 rejection, the main argument is MPEP 2131.02 (Examiner's Answer, page 33, line 2), which is a sec. 102 provision. That is, the examiner implicitly admits that the reference does not teach the limitations of claim 7, and is applying an attempted work-around to avoid the restriction against hindsight reconstruction.

Claim 8

The basis for the argument is to mix legal theories under sec. 102 and the examiner's newly proposed sec. 103 "can be" approach, selecting them as may be convenient to reconstruct the rejection. In this sec. 103 rejection, the main argument is MPEP 2131.02 (Examiner's Answer, page 34, last line on page), which is a sec. 102 provision. That is, the examiner implicitly admits that the reference does not teach the limitations of claim 8, and is applying an attempted work-around to avoid the restriction against hindsight reconstruction.

Claims 9-10

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-13-

The examiner does not disagree with the point that Ackerman does not disclose the claim limitation. Instead, it is argued that the claim limitation may be deduced from the discussion of Ackerman, but without showing that the limitations of claims 9 and 10 are met.

Claim 11

Ackerman does not arguably teach the recited limitation, as admitted in the Examiner's Answer at page 6, lines 8-9:

"Ackerman teaches all the features of these claims except the atomic ratio of the amount of the first element to the second element."

The examiner's position is now "routine experimentation." There is no reference to any teaching of Ackerman suggesting that Ackerman recognizes such an atomic ratio as a result-effective variable. Instead, in the examiner's hindsight view the "amount...would clearly be recognized as a result effective variable..." (Examiner's Answer, page 37, lines 11-17, emphasis added) Certainly "can be" clear to an examiner who has access to the present claims, but it was not clear to those skilled in the art.

Claims 12-14

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 15

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 16

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 17

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-14-

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 18

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 19

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 20

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Ground 3. Claims 1-12 and 14-20 are rejected under 35 USC 103 over Subramanian U.S. Patent 6,677,064.

Claims 1-5

The hindsight reconstruction of the rejections over Subramanian follows exactly the same pattern as those over Ackerman.

At Examiner's Answer, page 46, lines 6-7, it is admitted that "Subramanian, of course, provides for other combinations that are outside of the scope of appellant's claims." And then, to avoid the problem arising with the hindsight reconstruction, there is an immediate shift to reliance on MPEP 2132.02 (Examiner's Answer page 46, line 10-page 47, line 1), which deals with sec. 102 rejections. Then the argument shifts back to the sec. 103 line of argument and *In re McLaughlin* (Examiner's Answer, page 47, line 1-9).

Regarding the limitation on the atomic ratios of the first and second elements, we start from the admission that

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-15-

"...Subramanian does not teach the specific claimed ratio..."

(Examiner's Answer, page 48, line 11). Thus, it is admitted that Subramanian does not teach one of the key recited claim limitations found in every rejected claim.

However, there is exactly the same argument as to the limitation on the atomic ratio of the first and second elements as was found in relation to the Ground 2 rejection, extending from page 47, line 10 to page 48, line 13 of the Examiner's Answer, with a few minor variations. This argument is largely without any support in Subramanian. Applicant incorporates its responses set forth above, modified to apply to Subramanian.

Claim 6

The basis for the argument is to mix legal theories under sec. 102 and the examiner's newly proposed sec. 103 "can be" approach, selecting them as may be convenient to support the hindsight reconstruction and the rejection. In this sec. 103 rejection, the main argument is MPEP 2131.02 (Examiner's Answer, page 50, line 1), which is a sec. 102 provision. That is, the examiner implicitly admits that the reference does not teach the limitations of claim 6, and is applying an attempted work-around to avoid the restriction against hindsight reconstruction. Applicant incorporates its responses set forth above, modified to apply to Subramanian.

Claim 7

The basis for the argument is to mix legal theories under sec. 102 and the examiner's newly proposed sec. 103 "can be" approach, selecting them as may be convenient to reconstruct the rejection. In this sec. 103 rejection, the main argument is MPEP 2131.02 (Examiner's Answer, page 50, line 1), which is a sec. 102 provision. That is, the examiner implicitly admits that the reference does not teach the limitations of claim 7, and is applying an attempted work-around to avoid the restriction against hindsight reconstruction. Applicant incorporates its responses set forth above, modified to apply to Subramanian.

Claim 8

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-16-

The basis for the argument is to mix legal theories under sec. 102 and the examiner's newly proposed sec. 103 "can be" approach, selecting them as may be convenient to reconstruct the rejection. In this sec. 103 rejection, the main argument is MPEP 2131.02 (Examiner's Answer, page 54, line 1), which is a sec. 102 provision. That is, the examiner implicitly admits that the reference does not teach the limitations of claim 8, and is applying an attempted work-around to avoid the restriction against hindsight reconstruction. Applicant incorporates its responses set forth above, modified to apply to Subramanian.

Claims 9-10

The examiner does not disagree with the point that Subramanian does not disclose the claim limitation. Instead, it is argued that the claim limitation may be deduced from the discussion of Subramanian, but without showing that the limitations of claims 9 and 10 are met. Applicant incorporates its responses set forth above, modified to apply to Subramanian.

Claim 11

The Examiner's Answer admits at page 48, line 11 that

"...Subramanian does not teach the specific claimed ratio..."

The examiner's position is now shifted to one of "routine experimentation." There is no reference to any teaching of Subramanian suggesting that Subramanian recognizes such an atomic ratio as a result-effective variable. Instead, in the examiner's hindsight view the "amount...would clearly be recognized as a result effective variable..." (Examiner's Answer, page 56, lines 10-11, emphasis added) Nothing in Subramanian or elsewhere supports this position.

Claims 12-14

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-17-

Claim 15

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 16

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 17

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 18

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 19

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Claim 20

No new position is set forth in the Examiner's Answer. Applicant incorporates and stands on its comments previously presented.

Ground 4. Claim 13 is rejected under 35 USC 103 over Subramanian '064 in view of Taylor U.S. patent 5,520,516.

The Examiner's Answer seeks to introduce the "can be" standard in another fashion in this argument. The argument is made that, because a reference is not limited to a

Attorney Docket No.: 130014/11922 (21635-0117)
Application No.: 10/735,369

-18-

particular disclosed material, it may be interpreted to include a teaching to combine the teachings of the reference with the teachings of another reference dealing with entirely different materials.

The law requiring an objective basis for the combining of the teachings of two references, as set forth in MPEP 2142, does not use the "can be" or "not limited to" standards proposed by the examiner. MPEP 2142 unequivocally states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

These requirements are not met by the proposed combination of Subramanian and Taylor.

SUMMARY AND CONCLUSIONS

The decisional process underlying the rejections is flawed, because it is based upon proposed new legal standards and procedures proposed by the examiner but not within those permitted by the MPEP and the courts. The references simply do not teach the claim limitations, when the correct legal analysis is applied.

Respectfully submitted,

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PTO/5B/97 (09/04)

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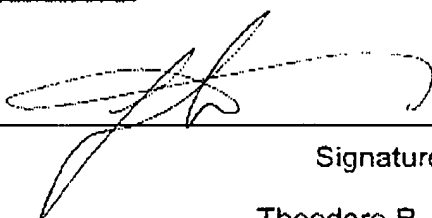
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